JUDGMENT OF THE COURT OF FIRST INSTANCE (Fourth Chamber)
17 March 2004 *

In Joined Cases T-183/02 and T-184/02,

El Corte Inglés, SA, established in Madrid (Spain), represented by J.L. Rivas Zurdo, lawyer,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by J. Crespo Carrillo, acting as Agent,

defendant,

supported by

in Case T-184/02,

Iberia Líneas Aéreas de España, SA, established in Madrid, represented by A. García Torres, lawyer,

* Language of the case: Spanish.

the other party to the proceedings before the Board of Appeal of OHIM in Case T-183/02 being

González Cabello, SA, established in Puente Genil (Spain),

ACTIONS brought against two decisions of the First Board of Appeal of OHIM of 22 March 2002 (Cases R 798/1999-1 and R 115/2000-1) relating to opposition proceedings between González Cabello, SA, and El Corte Inglés, SA, and between Iberia Líneas Aéreas de España, SA, and El Corte Inglés, SA, respectively,

THE COURT OF FIRST INSTANCE
OF THE EUROPEAN COMMUNITIES (Fourth Chamber),

composed of: V. Tiili, President, P. Mengozzi and M. Vilaras, Judges,

Registrar: J. Palacio González, Principal Administrator,

having regard to the written procedure and following the hearing on 5 November 2003,

gives the following

Judgment

Background to the dispute

1 On 17 June 1997, El Corte Inglés, SA, filed an application at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended, for registration as a Community trade mark of the word mark MUNDICOR.

2 Registration was sought in respect of almost all goods and services within the 42 classes of the seventh edition of the Nice Classification of goods and services for the purposes of registering trade marks of 15 June 1957, as revised and amended.

3 That application was published in the *Community Trade Marks Bulletin* No 27/98 of 14 April 1998.

4 On 14 July 1998, González Cabello, SA, and Iberia Líneas Aéreas de España, SA ('Iberia' or 'the intervener') each filed a notice of opposition against the registration of that Community mark pursuant to Article 42 of Regulation No 40/94.

Opposition of González Cabello

5 The notice of opposition filed by González Cabello was based on a likelihood of confusion, within the meaning of Article 8(1)(b) of Regulation No 40/94, with the Spanish word mark MUNDICOLOR lodged on 24 June 1996 and registered on 5 August 1997 under Number 2.036.336, which covers the following goods within Class 2 of the Nice Classification referred to above: 'Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.'

6 The opposition of González Cabello was directed against some of the goods covered by the application for a Community trade mark, namely the following goods within Class 2 of the Nice Classification: 'Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.'

7 By decision of 17 September 1999, the Opposition Division of OHIM found in favour of the notice of opposition of González Cabello in its entirety.

8 On 19 November 1999, the applicant filed a notice of appeal with the Board of Appeal against that decision of the Opposition Division.

9 By decision of 22 March 2002, in Case R 798/1999-1, the Board of Appeal dismissed that appeal, finding that there was a likelihood of confusion on the part

of the final consumer because of the similarity between the sign protected by the earlier trade mark and the sign in respect of which the Community trade mark application was made, and because of the identity, or quasi-identity, of the goods in question which the applicant had not challenged in the appeal.

Opposition of Iberia

10 The notice of opposition filed by Iberia was based on a likelihood of confusion, within the meaning of Article 8(1)(b) of Regulation No 40/94, with two earlier trade marks, namely:

— first, the Spanish word mark MUNDICOLOR lodged on 1 August 1973, registered under Nos 722.281 and 722.282 on 4 February 1977 and renewed on 15 April 1997, which covers 'transport services, excursions and promotions for holidaymakers' within Class 39, and 'hotel accommodation and the planning and organisation of holidays' within Class 42 of the Nice Classification, referred to above;

— second, the international figurative mark, comprising the words 'mundi' and 'color' valid, inter alia, in France, Italy, Austria, and the Benelux countries, lodged on 12 January 1978, registered under No 434.732 and renewed on 12 January 1998 in accordance with the Madrid Agreement concerning the international registration of marks of 14 April 1891, as revised and amended, which covers 'the planning and organisation of holidays' included in Class 39

and 'hotel services consisting of accommodation and meals' included in Class 42 of the Nice Classification. The figurative sign of that mark is reproduced below:



11 That opposition was directed against some of the services covered by the Community trade mark application, namely 'transport services; packaging and storage of goods; travel arrangement' under Class 39 and 'Providing of food and drink; temporary accommodation' under Class 42 of the Nice Classification.

12 By decision of 5 November 1999, the Opposition Division of OHIM found in favour of Iberia's notice of opposition, except in respect of 'packaging and storage of goods' within Class 39, covered by the Community trade mark application.

13 On 17 January 2000, the applicant filed a notice of appeal with the Board of Appeal against that decision of the Opposition Division.

14 By decision of 22 March 2002, in Case R 115/2000-1, the Board of Appeal dismissed that appeal, finding, inter alia, that there was a likelihood of confusion

because of the similarity between the sign protected by the earlier word mark and the sign in respect of which the Community trade mark application was made, having regard to the identity, or quasi-identity, of the services in question which the applicant had not challenged in the appeal.

Procedure and forms of order sought

15 By separate applications lodged at the Registry of the Court of First Instance on 11 June 2002, the applicant brought these actions, registered as Case T-183/02 and Case T-184/02 respectively.

16 In Case T-183/02, OHIM lodged its response at the Court Registry on 15 October 2002. González Cabello did not exercise its right of intervention under Article 134 (1) of the Rules of Procedure of the Court of First Instance.

17 In Case T-184/02, Iberia and OHIM lodged their responses at the Court Registry on 20 September and 15 October 2002 respectively.

18 By order of the President of the Fourth Chamber of the Court of First Instance of 15 September 2003, Cases T-183/02 and T-184/02 were joined for the purposes of the oral procedure and judgment, on account of the connection between them, pursuant to Article 50 of the Rules of Procedure.

19 In Case T-183/02, the applicant claims that the Court should:

— annul the decision of the Opposition Division of 17 September 1999 and the decision of the Board of Appeal of 22 March 2002 in Case R 798/1999-1;

— grant registration of MUNDICOR as a Community trade mark in respect of all goods sought within Class 2;

— order OHIM to pay the costs.

20 In Case T-184/02, the applicant claims that the Court should:

— annul the decision of the Opposition Division of 15 November 1999 and the decision of the Board of Appeal of 22 March 2002 in Case R 115/2000-1;

— grant registration of MUNDICOR as a Community trade mark in respect of all 'transport services and travel arrangement' within Class 39 and 'Providing of food and drink; temporary accommodation' within Class 42;

— order OHIM and the intervener to pay the costs.

21 In both cases, OHIM contends that the Court should:

— dismiss the actions;

— order the applicant to pay the costs.

22 In Case T-184/02, Iberia contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

23 At the hearing on 5 November 2003, the applicant withdrew its claim for annulment of the decisions of the Opposition Division, which the Court formally noted in the minutes of the hearing.

Law

24 In support of its actions, the applicant raises one plea in the joined cases alleging, essentially, infringement of Article 8(1)(b) of Regulation No 40/94, and in Case T-184/02, another plea essentially alleging infringement of Article 15(2)(a) and Article 43(2) of the same regulation.

25 It is necessary, first, to examine the second plea in law in so far as it seeks to challenge the very possibility of taking account of the earlier trade marks on which Iberia's opposition is based and of assessing whether there is a likelihood of confusion in relation to those marks, within the meaning of Article 8(1)(b) of Regulation No 40/942.

The plea in law, in Case T-184/02, alleging infringement of Article 15(2)(a) and Article 43(2) of Regulation No 40/94

Arguments of the parties

26 In Case T-184/02, the applicant considers that the opposition should have been dismissed in accordance with Article 43(2) of Regulation No 40/94 on the ground that the earlier marks were not used as they were registered.

27 It refers in that respect to the documentary evidence provided by Iberia itself to the Opposition Division from which it is apparent that the latter's trade marks were used jointly with the name of their proprietor and terms like 'mundos soñados' (perfect worlds) or 'hotel color', and that they were accompanied by individual graphics. In the light of those factors, it considers that the use made of the earlier marks has altered the distinctive character of those marks in the form in which they were registered. Consequently, Article 15(2)(a) of Regulation No 40/94 cannot apply in the present case.

28 The applicant stresses that, whilst, in the course of the opposition procedure, it did not require evidence of use of the earlier marks in accordance with Article 43(2) of Regulation No 40/94, that was because Iberia spontaneously presented that evidence. In the interests of procedural economy, it was therefore unnecessary for the applicant to request that Iberia adduce evidence of genuine use of the earlier marks which it had already submitted. In any event, since Regulation No 40/94 provides for the possibility that a trade mark may be nullified on the grounds of lack of genuine use, it is incumbent upon the opponent to furnish evidence of genuine use of its earlier mark and of any reputation of that mark.

29 OHIM defends the validity of the contested decision on that point by pointing out that the Board of Appeal rightly observed that the question of the use of earlier marks was not raised by the applicant before the Opposition Division.

30 It considers that the evidence of use and the claim of reputation are two different issues. Reputation was invoked by the opponent for its own benefit with a view to extending the protection of its earlier mark, in accordance with Article 8(5) of Regulation No 40/94, to goods or services which have no similarity with those in respect of which that mark is registered. On the other hand, in accordance with Article 43(2) of that regulation, proof of use must be furnished by the opponent 'if the applicant so requests', with a view to defending the scope of protection of the earlier mark. However, since the applicant did not request proof of use of the earlier marks within the allotted time, OHIM could not properly evaluate the evidence adduced by the opponent to demonstrate the reputation of the earlier marks for the purposes of Article 43(2) of Regulation No 40/94.

31 The intervener challenges the relevance of the applicant's arguments in respect of the effective use of the earlier marks. It alleges that it is the term 'mundicolor'

which is known and which is used in mass retailing. The combined use, in certain cases, of that term and its trading name is entirely normal. The terms 'mundos soñados' and 'hotel color' are never used in association with the trade mark MUNDICOLOR and do not correspond to the registrations of which the intervener is the proprietor.

Findings of the Court

32 By the present plea in law, the applicant essentially seeks a finding that the Board of Appeal erred in refusing to find that the intervener's earlier marks had not been put to genuine use in the Community in connection with the services in respect of which they were registered and which it cites as justification for its opposition, pursuant to Article 43(2) of Regulation No 40/94. In particular, it considers that the Board of Appeal should have taken account of the documents submitted by Iberia to the Opposition Division to show whether those documents proved use of the earlier marks in accordance with Article 43 of Regulation No 40/94 or whether, as the applicant claims, it is evidence to the contrary of a use altering the distinctive character of those marks in the form in which they were registered.

33 First of all, it is necessary to correct the reference made by the applicant to Article 43(2) of Regulation No 40/94, in so far as that paragraph only concerns the consequences of non-use of an earlier Community trade mark, whereas in the present case Iberia's earlier mark on the basis of which the opposition was upheld — the word mark MUNDICOLOR — is a national trade mark. The relevant provisions are in fact paragraphs 2 and 3 combined of that article, since paragraph 3 states that paragraph 2 'applies to earlier national trade marks referred to in Article 8(2)(a), by substituting use in the Member State in which the earlier national trade mark is protected for use in the Community'.

34 Furthermore, it should be stated that Article 15(2)(a) of Regulation No 40/94 relates likewise only to the Community trade mark. That provision defines the concept of use of the Community trade mark in terms of that regulation, for the purposes, in particular, of application of its provisions laying down penalties for non-use of such a mark. The earlier national marks invoked in the context of an opposition under Article 42 of Regulation No 40/94 and their use or non-use are not therefore governed by the provision in question.

35 It is not, however, necessary in the present case to address the question whether, for the purposes of the application of the combined provisions of Article 43(2) and (3) of Regulation No 40/94, the finding of use or non-use of an earlier national mark might also be made in the light of Article 15 of that regulation, on the basis of an application by analogy with that provision.

36 The Board of Appeal was therefore right not to dismiss the opposition on the basis of Article 43 of Regulation No 40/94, holding in the contested decision in Case T-184/02 (paragraph 18) that 'the question of the use of previously registered marks was not raised before the Opposition Division and was not formulated in the notice of appeal'.

37 In that connection, it should be noted that, pursuant to that article, it is only when the applicant so requests that the proprietor of an earlier trade mark who has given notice of opposition is called upon to furnish proof that, during the period of five years preceding the date of publication of the Community trade mark application, the earlier trade mark has been put to genuine use in the territory in which it is protected in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons for non-use.

38 Essentially, pursuant to Article 43(2) and (3) of Regulation No 40/94, for the purposes of examining an opposition introduced under Article 42 of that regulation, the earlier mark is presumed to have been put to genuine use as long as the applicant does not request proof of that use. The presentation of such a request therefore has the effect of shifting the burden of proof to the opponent to demonstrate genuine use (or the existence of proper reasons for non-use) upon pain of having his opposition dismissed, that proof having to be provided within the time allotted by OHIM in accordance with Rule 22 of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1). For that to occur, the request must be made expressly and timeously to OHIM.

39 It follows that the lack of proof of genuine use can only be penalised by rejecting the opposition where the applicant expressly and timeously requested such proof before OHIM.

40 In the present case, the applicant accepts that it never presented to OHIM the request referred to in Article 43(2) of Regulation No 40/94.

41 Consequently, having regard also to Article 74(1) of Regulation No 40/94, which provides that 'in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought', neither the Opposition Division nor the Board of Appeal could dismiss the opposition on the basis of Article 43(2) and (3) of Regulation No 40/94.

42 That conclusion is not undermined by the applicant's argument that it did not request proof of use on the ground that Iberia had spontaneously presented before the Opposition Division documents which showed that it had made use of the earlier marks in a form other than that in which they had been registered.

43 That argument is manifestly unfounded. It is apparent from the case-file that Iberia did not produce the documents in question to the Opposition Division to prove use of its earlier marks, but in order to prove the reputation of those marks and thus to substantiate the existence of a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see, to that effect, the case-law cited at paragraph 67 below). However, the production of such documents cannot, in any event, replace the requirement for an express request on the part of the applicant that there be proof of genuine use so that the question of such use must be examined and decided by OHIM.

44 In those circumstances, it is not necessary (paragraph 19 of the contested decision in Case T-184/02) to address the question, as the Board of Appeal did for the sake of completeness, whether or not that document is evidence of use by Iberia of the trade mark MUNDICOLOR in accordance with the requirements of Article 43 of Regulation No 40/94.

45 The present plea must therefore be rejected.

The plea alleging infringement of Article 8(1)(b) of Regulation No 40/94

Arguments of the parties

46 The applicant points out that, pursuant to Article 8(1)(b) of Regulation No 40/94, the refusal to register requires cumulatively the identity or similarity of the signs and the identity or similarity of the goods or services covered. It also points out that, where there is no likelihood of confusion between the signs, the identity of the goods and services covered by them is not relevant for the purposes of the application of that provision.

47 In the present case, it submits that even if the goods and services in question move through the same commercial channels, the overall differences between the signs are sufficiently great to dispel any likelihood of confusion.

48 First, the applicant highlights the aural difference between the signs. It points to the different number of syllables and letters which make up the signs, namely three syllables and eight letters in 'mundicor' and four syllables and 10 letters in 'mundicolor'. There is a clear difference between the signs, not merely from the point of view of their sound, in particular because of the different composition of the suffixes 'cor' and 'color', but also in terms of the tonic accent, rhythm and musicality: the mark applied for ends abruptly on a stressed third syllable whilst the final part of the MUNDICOLOR marks is much less abrupt, it being one syllable longer, also stressed.

49 Second, the applicant points to the visual difference between the signs in issue, arising from the different number of letters they contain. It stresses in particular that the mark applied for is shorter than the earlier MUNDICOLOR marks.

50 In Case T-184/02, the applicant adds that the visual difference is even more pronounced if the trade mark applied for is compared with the earlier international mark on account of the characteristic and distinctive graphics of the latter and the separation of the words 'mundi' and 'color'. Furthermore, it compares the mark applied for with Iberia's signs as they appear in the documents that company submitted to OHIM to prove the reputation of its earlier marks. The applicant thus points out that, in most cases, Iberia's earlier marks are mixed, have characteristic graphics and also include the words 'Iberia', 'mundos soñados' or 'hotel color', which are significant distinctive elements in comparison with the mark applied for.

51 Third, it emphasises the conceptual difference between the opposing signs.

52 Thus, it considers, first, that the prefix 'mundi', which refers in generic terms to the words 'mundial' (global) or 'mundo' (world), is not distinctive in itself. Indeed many registered trade marks include that prefix. The conceptual comparison should therefore focus specifically on the suffixes 'color' and 'cor'.

53 Second, the applicant submits that in the sign MUNDICOLOR, the prefix 'mundi', which is intrinsically connected to the word 'color' clearly refers to a specific sector of reality, namely the world of colours, and not to the earth which the sign MUNDICOR evokes. However, it points out that the prefix 'mundi', when attached to the particle 'cor', tends to lose all evocative content and becomes an element of pure fantasy.

54 Third, the applicant notes that the suffix 'color' (colour) has a clear meaning and, in the case of González Cabello's earlier mark, refers to the type of goods covered by that mark, whilst the suffix 'cor' has no immediate meaning.

55 Fourth, it considers that the opposing signs may readily be associated, in the minds of consumers, with their respective proprietors and with the reputation of that proprietor on the market. First, the applicant uses many registered trade marks ending in 'cor' and its reputation on the Spanish market is sufficiently high that other signs which also end in 'cor' may also be associated with it. Second, it is

apparent from the documents submitted by Iberia to the Opposition Division that the earlier marks in question in Case T-184/02 are associated with the well-known name of their proprietor or with other verbal elements like 'mundos soñados' or 'hotel color' which clearly identify the commercial origin of those marks.

56 In order to prove the existence of, first, a multitude of national registered trade marks which belong to it and which end in the suffix 'cor' and a multitude of Community registered trade marks including the words 'mundi' or 'mundo', the applicant in the two cases produces several documents and invites the Court to send requests for information to the Oficina Española de Patentes y Marcas (Spanish Patent and Trade Mark Office) and to OHIM under Article 65(b) of the Rules of Procedure.

57 OHIM points out that the global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between the goods or services covered.

58 As regards the comparison between the goods and services, OHIM insists in the two cases on the identity or quasi-identity of the goods and services covered by the marks in issue.

59 As regards the comparison between the signs, OHIM emphasises, in Case T-184/02, that since the Opposition Division and the Board of Appeal found in favour of Iberia's opposition in respect of the Spanish word mark MUNDI-COLOR alone, it is not appropriate to compare the mark applied for with the international figurative mark upon which Iberia also based its opposition. In the same case, OHIM further notes that the comparison between the marks must be based on the signs as they were registered.

60 From a global comparison of the opposing signs MUNDICOR and MUNDICOLOR, OHIM concludes in the two cases that they are visually and aurally very similar, although there is no relevant conceptual similarity between them.

61 There is therefore a likelihood of confusion on the part of the public in the Member State concerned, namely Spain, because of the similarity of the opposing signs and the identity or substantial similarity of the goods and services which they cover.

62 The intervener in Case T-184/02 essentially adopts the arguments put forward by OHIM and submits, in particular, that in the present case the similarity of the opposing marks is amply demonstrated. Referring to the findings of the Board of Appeal in respect of the visual and aural similarity of the signs in question, which it considers well founded, the intervener further points to a conceptual similarity between the words 'mundicor' and 'mundicolor', given that the common prefix 'mundi', referring to 'mundo' (world) or 'mundial' (global), is the predominant conceptual element.

63 Having regard to the exact match, found by the Board of Appeal, between the services covered by the Community trade mark application and the services covered by its earlier marks, the intervener alleges that the registration and use of the mark applied for in the same commercial sector as that in which its own marks circulate inevitably, given the reputation of those marks, gives rise to a likelihood of confusion and association on the part of the public and causes the intervener serious harm. The intervener points out, in substantiating the reputation of its earlier marks, that it registered the word mark MUNDICOLOR in numerous countries throughout the world and that it is the proprietor, in addition to the marks upon which its opposition is based, of other figurative marks comprising the word 'mundicolor', registered in Spain or other European countries.

Findings of the Court

64 According to the case-law of the Court of Justice on the interpretation of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), and of the Court of First Instance on Regulation No 40/94, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion (Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 29; Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 17; Case T-104/01 *Oberhauser* v *OHIM— Petit Liberto (Fifties)* [2002] ECR II-4359, paragraph 25, and Case T-99/01 *Mystery Drinks* v *OHIM — Karlsberg Brauerei (MYSTERY)* [2003] ECR II-43, paragraph 29).

65 The likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case (Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 22; *Canon*, cited above, paragraph 16; *Lloyd Schuhfabrik Meyer*, cited above, paragraph 18; Case C-425/98 *Marca Mode* [2000] ECR I-4861, paragraph 40; *Fifties*, cited above, paragraph 26, and *MYSTERY*, cited above, paragraph 30).

66 That global assessment implies some interdependence between the relevant factors, and, in particular between the similarity between the trade marks and between the goods or services covered. Accordingly, a lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of those factors finds expression in the seventh recital in the preamble to Regulation No 40/94, which provides that the concept of similarity should be interpreted in relation to the likelihood of confusion, the appreciation of which in turn depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the trade mark and the sign and between the goods or services identified (*Canon*, cited above, paragraph 17; *Lloyd Schuhfabrik Meyer*, cited above, paragraph 19; *Fifties*, cited above, paragraph 27, and *MYSTERY*, cited above, paragraph 31).

67 Furthermore, it is apparent from the case-law that the more distinctive the earlier mark, the greater will be the likelihood of confusion (*SABEL*, cited above, paragraph 24, and *Canon*, cited above, paragraph 18), that distinctiveness being established either in the light of the intrinsic qualities of the mark or owing to the reputation associated with it (*Canon*, cited above, paragraph 18, and MYSTERY, cited above, paragraph 34).

68 In addition, the perception of the marks in the mind of the average consumer of the goods or services in question plays a decisive role in the global assessment of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*SABEL*, cited above, paragraph 23; *Lloyd Schuhfabrik Meyer*, cited above, paragraph 25; *Fifties*, cited above, paragraph 28, and *MYSTERY*, cited above, paragraph 32). For the purposes of that global assessment, the average consumer of the products concerned is deemed to be reasonably well informed and reasonably observant and circumspect. In addition, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but has to place his trust in the imperfect image of them that he has retained in his mind. It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (*Lloyd Schuhfabrik Meyer*, cited above, paragraph 26; *Fifties*, cited above, paragraph 28, and *MYSTERY*, cited above, paragraph 32).

69 In the present case, it should be pointed out that González Cabello and Iberia each filed a notice of opposition to the Community trade mark applied for, by invoking the likelihood of confusion, within the meaning of Article 8(1)(b) of Regulation No 40/94, with the Spanish word mark MUNDICOLOR, which covers goods within Class 2 of the Nice Classification, cited above, and with the Spanish word mark MUNDICOLOR and the international figurative mark comprised of the words 'mundi' and 'color', which cover services falling within Classes 39 and 42 of that classification.

70 In the contested decision in Case T-184/02 (paragraph 16), the Board of Appeal pointed out that, having rightly found that there was a likelihood of confusion between the mark applied for and Iberia's Spanish word mark, the Opposition Division could properly refrain from carrying out an assessment of the likelihood of confusion between the mark applied for and the earlier international figurative mark. Thus it rejected the applicant's complaint alleging a failure to make such an assessment and refrained in turn from making that assessment.

71 The applicant cannot complain about the reasoning on the part of the Board of Appeal to the effect that 'if an opposition is only upheld in respect of one of the rights opposed to the mark applied for, there is no need to examine the extent to which it might also uphold the opposition in respect of the remaining rights relied on' (contested decision, paragraph 16).

72 Since Iberia's opposition was twice upheld on the basis of the earlier word mark, any considerations in respect of the degree of similarity between the mark applied for and the earlier figurative mark can only be relevant where the Court, on the basis of other arguments advanced by the applicant, excludes, contrary to the finding of the Board of Appeal, a likelihood of confusion on the part of the Spanish public between the mark applied for and Iberia's earlier word mark.

73 Accordingly, in examining the present plea in law, it is necessary to proceed directly to the assessment of the likelihood of confusion between the Community word mark applied for, MUNDICOR, and the earlier word marks, MUNDICOLOR, belonging to González Cabello and Iberia.

74 Given the nature of the goods and services in issue, which are items of everyday consumption, and the fact that the earlier word marks are registered and protected in Spain, the target public in respect of which the assessment of likelihood of confusion must be carried out is made up of average consumers in that Member State, who are, for the most part, Spanish-speaking.

— Comparison of the goods and services in question

75 As regards the comparison of the goods and services, it should be pointed out that in the two contested decisions the Board of Appeal, without carrying out its own analysis, held that there was identity or quasi-identity between, first, the goods and services covered by the earlier word marks and, second, the goods and services covered by the Community trade mark application in respect of which the opposition was upheld. It found that the applicant did not challenge that assessment made by the Opposition Division.

76 Since the applicant also does not challenge that assessment in the present actions and consequently accepts it as given that there is a very high level of similarity (identity or quasi-identity) between the goods and services covered by the opposing marks, but claims by contrast that these are not similar or, a fortiori, identical and that there is no likelihood of confusion between them, assessment should be limited to those two points.

— Comparison of the opposing signs

77 According to the case-law, the global assessment of the likelihood of confusion, as regards the visual, aural or conceptual similarity of the marks in question, must be

based on the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components (*SABEL*, cited above, paragraph 23; *Lloyd Schuhfabrik Meyer*, cited above, paragraph 25, and *Canon*, cited above, paragraph 16). Furthermore, the Court of Justice has held that it is possible that mere aural similarity between trade marks may create a likelihood of confusion (*Lloyd Schuhfabrik Meyer*, cited above, paragraph 28).

78 It is therefore necessary to compare the visual, aural and conceptual aspects of the conflicting signs, noting that the terms for that comparison are, as OHIM rightly points out, provided by, first, the Community trade mark applied for and, second, in accordance with Article 8(2)(a)(ii) of Regulation No 40/94, the earlier marks as they were registered in Spain, namely the verbal sign MUNDICOLOR.

79 In the contested decision in Case T-183/02, the Board of Appeal did not carry out a visual comparison of the signs MUNDICOR and MUNDICOLOR, but focused on the aural similarity between them, which the applicant had challenged before it. It noted in this connection that 'the two marks have in common the first seven letters which also form their first three syllables, and the last letter'; that the only difference between those marks is the addition of the letters 'lo' which are the fourth syllable of the earlier mark; that, being inserted between the letters 'o' and 'r', those additional letters do not alter 'to an appreciable extent the sound pattern of the sign'; and that 'it is usually the first syllables which most influence the consumer's perception' (paragraph 16 of that decision).

80 In the contested decision in Case T-184/02, the Board of Appeal made a combined visual and aural comparison of the marks MUNDICOR and MUNDICOLOR, emphasising that these 'have the first seven and last letters in common, ... have the same visual appearance and the same sound pattern', and differ solely in that the

applicant's mark ends in 'or', whereas the opposing mark ends in 'olor'. Since that difference occurs at the end of the two words, it attracts less attention and therefore does not substantially alter the clear visual and aural similarity of the two signs (paragraph 21 of that decision).

81 It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters 'lo' which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter 'r', which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root 'mundico' in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter 'r' at the end of the two signs. Given those similarities, the applicant's argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82 As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83 Second, the first two syllables of the opposing signs forming the prefix 'mundi' are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.

84 Third, according to the rules of syllabification and accentuation peculiar to the Spanish language, the opposing signs are composed of four and three syllables respectively, namely 'mun-di-co-lor' and 'mun-di-cor', and the tonic accent in the two signs falls on the last syllable 'lor' and 'cor' respectively. The letters forming the final syllable of the mark applied for, namely 'cor', are all present in the earlier marks and more particularly in the final two syllables thereof. The syllables 'lor' and 'cor' which end the two signs have in common, in addition to the vowel 'o', on which the tonic accent falls, the final consonant 'r', which in Spanish is characterised by a very strong pronunciation. Those features make the sound very similar.

85 In the light of those considerations, the applicant's argument based on the presence of the additional letters 'lo' and an additional syllable in the earlier marks does not dispel the marked aural similarity between the signs, which must be assessed on the basis of the overall impression produced by their full pronunciation.

86 As regards the conceptual comparison, the Board of Appeal held in Case T-183/02, inter alia, 'that the difference between the very specific expression "El Corte Inglés" and the simple and relatively banal ending "cor" is so great that the target public, made up of average consumers who are reasonably well informed and reasonably observant and circumspect ..., will neither associate nor immediately identify that final part of the ... Community mark [applied for] with the undertaking El Corte Inglés, well known as the latter is' (paragraph 17 of that decision).

87 In the contested decision in Case T-184/02, the Board of Appeal noted that 'the word part ["mundi"], in spite of being used frequently in the field of distribution

and marketing of goods and services, is not a generic term likely to be deprived of any distinctive character'. Such a word is 'an intrinsic part of the marks in issue in the dispute, ... visually and aurally perceived as such by the ordinary consumer' (paragraph 21 of that decision).

88 First, as OHIM acknowledged in its pleadings, there is no significant conceptual similarity between the opposing marks.

89 The latter certainly have in common the word 'mundi', which, although it does not correspond to any word in the Spanish language, has a certain evocative force in that it is very close, having regard also to its meaning in Latin ('of the world'), to the noun 'mundo' (world) and the adjective 'mundial' (global).

90 However, the word 'mundi' is only a prefix in the opposing marks, whereas their conceptual similarity must be assessed on the basis of the evocative force that may be recognised in each of them taken as a whole. In this connection it should be noted that, whilst in the earlier marks the prefix 'mundi' is accompanied by the noun 'color' (colour) to form a word which, without having any clear and determined meaning, nevertheless evokes ideas (like 'colours of the world' or 'the world in colours') likely to be understood by the target public, in the mark applied for the same prefix is accompanied by the suffix 'cor', a term which has no meaning in the Spanish language, so that the mark, notwithstanding the evocative force of the prefix 'mundi', is ultimately deprived of any particular conceptual force for that public.

91 It should be added that in the marks MUNDICOLOR, the term 'mundi' does not necessarily appear to be the dominant element in conceptual terms, since it is associated with another term ('color') which has an even more precise meaning (colour). Furthermore, as OHIM stated in its pleadings, the term 'mundi' is often used in the marketing of goods or services. In those circumstances, it cannot constitute a conceptual link between the opposing marks so as to lead to the conclusion that those are conceptually similar.

92 Accordingly, it is unnecessary to examine the documents produced by the applicant in support of its allegation that the prefix 'mundi' in the two signs does not give rise to any conceptual similarity between them or to uphold the applicant's request that the Court seek information from OHIM.

93 Second, it should be noted that the conceptual differences which distinguish the opposing marks may be such as to counteract to a large extent the visual and aural similarities between those marks. For there to be such a counteraction, however, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately and the other mark must have no such meaning or an entirely different meaning (judgment of 14 October 2003 in Case T-292/01 *Phillips-Van Heusen* v *OHIM— Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, paragraph 54.

94 However, it is clear that those conditions are not met in the present case.

95 First, whilst the MUNDICOLOR marks have a certain evocative force they cannot be regarded as having any clear and specific meaning in the mind of the relevant public (see paragraph 90 above).

96 Second, the mark MUNDICOR is also devoid of any such meaning as the applicant's argument in relation to the alleged conceptual link between the signs ending in 'cor' and its name El Corte Inglés cannot be upheld. In this connection, it should be noted that, regardless of the reputation which the applicant enjoys in the Spanish market, the fact that it has registered a number of marks ending in 'cor' does not prove that the Spanish public associates all other signs ending in 'cor' with the applicant, and in particular the mark applied for, MUNDICOR, since the Board of Appeal rightly highlighted the substantial difference between the expression 'El Corte Inglés' and the simple suffix 'cor' in the contested decision in Case T-183/02 (see paragraph 86 above). In order to demonstrate such an association in the mind of the target public, the applicant advanced before OHIM and during these proceedings mere assertions unsupported by evidence.

97 Thus, the offer of evidence by the applicant to show that the multitude of national marks ending in 'cor' of which it is allegedly the proprietor — in addition to being inadmissible on the ground that the admission of such evidence for the first time before the Court of First Instance is contrary to Article 135(4) of the Rules of Procedure (see, to that effect, the judgment of 6 March 2003 in Case T-128/01 *DaimlerChrysler* v *OHIM (Vehicle grille)*, [2003]ECR II-701, paragraph 18) — must also be rejected on the ground that it is irrelevant.

98 Furthermore, it cannot be ignored that the opposing marks have in common the prefix 'mundi', which has a certain evocative force (see paragraph 89 above); although that does not constitute a link such as to give rise to conceptual

similarity between those marks (paragraph 91 above), it nevertheless limits their conceptual difference. It should be noted in that connection that in the mark applied for that prefix is, in any event, the dominant conceptual feature.

99 In those circumstances, it cannot be asserted that there is a conceptual difference between the opposing marks which neutralises the pronounced visual and aural similarity.

100 Accordingly, the Board of Appeal was right to find that the opposing signs are similar within the meaning of Article 8(1)(b) of Regulation No 40/94.

— The likelihood of confusion

101 Since it is not in dispute that the goods and services covered by the opposing marks are identical or very similar and it has been found that these are similar, from the point of view of their strong aural and visual similarities, there is, a priori, a likelihood of confusion on the part of the target public.

102 However, in Case T-184/02, the applicant further claims that, in the present case, the likelihood of confusion should not be assessed solely on the basis of similarities or differences between the opposing signs, but also in relation to the association of those signs, in the use specifically made of them by their proprietor

on the market, with other verbal or graphic elements which are not part of the registered mark. It submits in this connection that the mark applied for is always associated with its name, which is well known, and that Iberia in fact uses its mark by associating it with its name, no less well known in Spain, or with other verbal elements clearly identifying the commercial origin of the sign, such that the likelihood of confusion on the part of consumers is, in practice, non-existent.

103 That argument must be rejected.

104 First, as regards the alleged association between the mark applied for and the name of the applicant, it has already been found at paragraph 96 above that no evidence has been adduced by the latter to show that such an association is in fact made by the target public. Furthermore, in so far as the applicant alludes to a potential intention always to use the mark applied for in combination with the name 'El Corte Inglés', it suffices to point out that its application for a Community trade mark only refers to the word sign MUNDICOR, associated with no other element, so that that alleged intention is immaterial.

105 Second, the fact, alleged by the applicant that the sign MUNDICOLOR can be used by its proprietor, Iberia, in combination with other verbal or figurative elements has no bearing on the assessment of the likelihood of confusion within the meaning of Article 8(1)(b) of that regulation. As long as it remains the proprietor of its earlier mark, Iberia may in principle use the verbal sign of which it is composed, without associating it with other factors, and may make use of that protected sign, subject to the application of Article 43(2) of Regulation No 40/94,

to oppose registration of a Community trade mark which would give rise to a likelihood of confusion with that sign within the meaning of Article 8(1)(b) of that regulation.

106 In the light of the foregoing considerations, the Board of Appeal was right to find, in the contested decisions, that there was a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 between the mark applied for, MUNDICOR, and the earlier MUNDICOLOR marks. Accordingly, the plea in law in the two cases alleging infringement of that article must be dismissed, without it being necessary, in Case T-184/02, to consider whether the alleged reputation of Iberia's earlier mark — raised by the intervener in support of there being a likelihood of confusion in the present case in the light of the case-law cited at paragraph 67 above — or whether there is also a likelihood of confusion with the other earlier mark on which Iberia based its opposition, namely the international figurative mark comprising the terms 'mundi' and 'color'.

107 It follows from the foregoing that the present actions must be dismissed in their entirety.

Costs

108 Under Article 87(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been asked for in the successful party's pleadings. Since the applicant has been unsuccessful, and OHIM and the intervener have asked for costs, it must pay the costs of OHIM and the intervener.

On those grounds,

THE COURT OF FIRST INSTANCE (Fourth Chamber)

hereby:

1. **Dismisses the actions;**

2. **Orders the applicant to pay the costs.**

Tiili Mengozzi Vilaras

Delivered in open court in Luxembourg on 17 March 2004.

H. Jung
Registrar

V. Tiili
President